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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/961,424 | 09/25/2001 | Mitsuru Yamamoto | 862.C2388 | 6884 |

5514 7590 12/05/2007
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NEW YORK, NY 10112

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| EXAMINER |
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BROWN, RUEBEN M

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| ART UNIT | PAPER NUMBER |
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2623

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| MAIL DATE | DELIVERY MODE |
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12/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/961,424 | YAMAMOTO, MITSURU | |
| | Examiner | Art Unit | |
| | Reuben M. Brown | 2623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/18/04; 7/26/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7, 10-15, 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by McCissock, (U.S. PG-PUB 2006/0190966).

Considering claim 1, the claimed communication system comprising ‘a plurality of first terminals connected to a first transmission path for transmitting first information’ is met by any plurality of user terminals in McCissock, for example, Fig. 2A shows a plurality of user TV equipment 88 connected to TV Distribution Facility 84, (TVDF).

The additionally claimed ‘second plurality of terminals connected to a second transmission path for transmitting second information’, is met by any different plurality of user

terminals in McCissock, for example, Fig. 2A shows a different plurality of user TV equipment 92 connected to TV Distribution facility 84. It is clear that McCissock supports a plurality of different TVDF 84, all of which may be connected to a plurality of user TV equipment.

The server connected to the first and second paths reads on any of the TVDF 84 in McCissock, which again may be connected to a plurality of different user TV equipment.

‘wherein the second information is transmitted from the server to one of the plurality of terminals’, reads on any one of the TVDF in McCissock transmitting video signals to any one of the connected plurality of user TV equipment.

‘and the first information is transmitted from one of the first plurality of first terminals to the server to control the transmission of the second information from the server’, reads on the disclosure in McCissock that a subscriber may order a gift video program using their own user TV equipment, to be transmitted from the TVDF 84 to a recipient subscriber terminal on the system, other than themselves, see Para [0096] & [0135].

The subscriber ordering the video program gift for a recipient corresponds with the claimed ‘first terminal’, whereas the recipient that receives the video program gift corresponds with claimed ‘second terminal’.

Considering claims 2 & 12, McCissock teaches that the gift may be a pay-per-view video program, see Abstract; Fig. 21; Para [0096] & [0135].

Considering claims 3 & 13, the claimed 'outputting the second information' reads on the recipient terminal displaying the received gift pay-per-view programming.

Considering claim 4, the claimed feature reads on the particular TVDF 84 transmitting the pay-per-view programming to the recipient selected by the first terminal. The limitations of the claim are met since McCissock does not discuss that the video program is transmitted from a subscriber's user TV equipment to the TVDF, and then distributed to the recipient.

Considering claim 5, the claimed subject matter reads on the subscriber choosing a particular recipient, as shown in Fig. 21.

Considering claims 6-7 & 14-15, the claimed subject matter reads on messages transmitted from the first terminal in McCissock to the recipient terminal, which may serve as notification of name, date, time channel of the gift program, see [0079-0081]; [0096-0097]; [0101-0103] & [0114-0120] & [0137] & [0142].

Considering claims 10 & 18, the claimed, 'first designation information for designating one of a plurality of pieces of information held in a server, and second information for designating one of a plurality of second terminals', is met by [0096-0097]; [0136-0140]. As for

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the additionally claimed, 'second information is information which is read out from the server on the basis of the first information, and is transmitted from the server to the second terminal designated by the instant second designation information', is inherent in McCissock, see Fig. 21.

Considering claim 11, the claimed information transmission method, substantially corresponds with subject matter mentioned above in the rejection of claim 1, and is likewise treated.

Considering claim 19, since McCissock is a computerized system the claimed elements that correspond with subject matter mentioned above in the rejection of claims 1 is also met.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-9, 16-17, 20-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCissock, in view of Harma, (U.S PG-PUB 2001/0053691).

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Considering claims 8-9 & 16-17, even though since McCissock is directed to terminals transmitting messages to/from each other, the reference does not specifically discuss any of the messages concerning initialization results or notifying the first terminal that the downloaded second information has started in the instant second terminal. Nevertheless Harma, which is in the same field of endeavor and provides a teaching of a second terminal that receives content information from a server (see, Harma Para [0070-0072], which may be at the request of a first terminal), and thus corresponds with McCissock. Once the content information is received by the second terminal, the instant second terminal sends an acknowledgement to the first terminal, which meets the claimed subject matter, see Harma Para [0042-0045].

It would have been obvious for one ordinary skill in the art at the time the invention was made, to modify McCissock by the second terminal transmitting an acknowledgement to the first terminal indicating that the content has been received, is initialized and/or has begun, at least for the purpose of informing the first the first user that the second user is in fact utilizing the content, as taught by Harma, which is especially useful in the instance of multi-user interactive applications, which is commonly available to user in both McCissock & Harma. Harma [0034] teaches that the content may take a variety of form(s), such as a film, which corresponds with the video gift(s) disclosed in McCissock.

Considering claims 20, 26, 28, 31 & 37, the claimed elements of a server, and a terminal connected to a server corresponds with subject matter mentioned above in the rejection of claims 1-7 & 10-15 and are likewise treated. Additionally, McCissock discusses a video display device,

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which is used to control the system, which also meets the claimed language, see Fig. 2; col. 4, lines 25-65. As for the further claimed features of, 'confirmation transmission means for', 'request confirmation means for', the TVDF in McCissock teaches receiving the gift selection information from the first user, [0137-0142], but does not explicitly discuss transmission/reception of confirmation information. Nevertheless, Harma teaches that the server may receive and then forward confirmation information, see Fig. 1; Fig. 2; Fig. 3; Para [0042-0046]. It would have been obvious for one ordinary skill in the art at the time the invention was made, to modify McCissock with the technology of confirmation messages, as taught by Harma, at least purpose enabling the server to further facilitate the transfer/processing of content information from the serve to one or more terminals.

As for 'comparison means for comparing identification information of the first terminal', and 'second comparison means for comparing the second conformation information contained in the request confirmation information' also corresponds with the operation of the TVDF that when receiving the first terminal's designation of the recipient terminal provides a screen that allows the instant first user to see the selected recipient on the screen, see Fig. Fig. 19; -24; Para [0135-0142].

Considering claims 21 & 32, see Harma [0050-0054].

Considering claims 22 & 33, see McCissock [0114].

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Considering claims 23 & 34, the claimed subject matter corresponds with “the gift information relating to a TV program may also be provided for a specific program on a program information screen”, [0136].

Considering claims 24 & 35, McCissock teaches that the gift transmitted by the user to a second user, may be a video program, and thus meets the claimed subject matter.

Considering claims 25 & 36, McCissock does not discuss the confirmation being a random number. Official Notice is taken that associating a random number as an identification code, such as using RSA was well known in the art. It would have been obvious for one ordinary skill in the art at the time the invention was made, to modify McCissock with the feature using a random number for the well-known advantage of using a security method to ensure only authorized terminals receive and/or display the protected video programs.

Considering claim 27, see Harma Para [0046 7 0048]; Figs. 1-4.

Considering claim 29, the terminals in McCissock provide display means for each of the terminals.

Considering claim 30, the claimed subject matter reads on the first terminal selecting only a single recipient.

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Any response to this action should be mailed to:

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or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

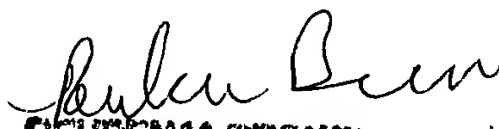
(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown


REUBEN M. BROWN
PATENT EXAMINER